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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,561	06/02/2006	Katsuhiro Ando	062554	5391
38834 7590 06/23/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER LOEWE, ROBERT S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/581,561

**Applicant(s)**

ANDO ET AL.

**Examiner**

ROBERT LOEWE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments of 6/18/09 have been fully considered and are found to be persuasive; however, Okamoto et al. (WO-03011978) is still relied upon as an obviousness-type reference. Specifically, Applicants argue that EP505S is not a silyl-capped polyoxypolypropylene as required by the instant claims but rather a silyl-capped polyisobutylene polymer. The Examiner does not dispute this assertion. However, the specification of Okamoto et al. clearly teaches that silyl-capped polyoxypolypropylene polymers may be employed. Further, such polymers are exemplified in many of the working examples presented by Okamoto et al.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (WO-03/11978). For convenience, the English-language equivalent US Pat. 7,115,695 will be relied upon.

Claim 2: Okamoto et al. teaches a curable compositions which may comprise a silicon-group terminated polyoxyalkylene polymer [component (A) of Okamoto et al.], a condensation catalyst [component (B) of Okamoto et al.], an amine compound [component (C) of Okamoto et al.], an epoxy resin (20:1-29), a curing agent for the epoxy resin (20:30-53), and a silane coupling agent (21:6 and examples). Okamoto et al. teaches that component (A) may be a silyl-capped polyoxypropylene polymer (4:38-39 and component (A-1) of working examples). The silane coupling agents are employed in amounts which satisfy the range of instant claim 1 (Table 2). Okamoto et al. teaches that the amount of epoxy resin may preferably be employed from 10 to 50 parts by weight per 100 parts by weight of polyoxyalkylene polymer (20:45-49). Okamoto et al. further teaches that the curing agent for the epoxy resin includes amine-based compounds, such as tertiary amines (20:36). Okamoto et al. further teaches that the amine-based compound [component (C) of Okamoto et al.] includes those amines which have a melting point of 20 °C or more (e.g., laurylamine, which is exemplified by Okamoto et al.). Last, water is employed in many of the working examples within the claimed range. Okamoto et al. teaches or suggests curable compositions which would comprise the claimed ingredients in the claimed amounts. Therefore, a person having ordinary skill in the art would have found it obvious to prepare the curable compositions as claimed given the overall teachings of Okamoto et al.

Claim 3: While Okamoto et al. does not explicitly teach the claimed viscosity and structural viscosity index required by instant claim 3, Okamoto et al. is cognizant about obtaining

workable viscosities (15:44-48). It is very well known that adjusting the viscosity of a composition within the realm of routine experimentation. A person having ordinary skill in the art appreciates the processing difficulties which may arise should the viscosity of the curable composition be too high or too low. Further, since Okamoto et al. teaches compositions comprising the same claimed ingredients, it is believed that the compositions taught by Okamoto et al. would have the same physical properties as claimed.

Claim 4: Okamoto et al. teaches that fillers may also be employed (19:22-39 and examples).

Claim 5: Okamoto et al. exemplifies the primary amine laurylamine as a curing promoter.

Claim 6: Okamoto et al. teaches that the curable compositions therein may serve as coating/sealing materials (21:17-32).

Claims 7 and 8: Okamoto et al. teaches that the epoxy resin curing agent may be 2,4,6-tris(dimethylaminomethyl)phenol (20:37-38).

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-13021302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./  
Examiner, Art Unit 1796  
22-Jun-09

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796